

REMARKS/ARGUMENTS

Allowable Subject Matter

The Applicant notes the Examining Attorney has only objected to claims 5, 6 and 17, indicating they would be allowable over the art if rewritten in independent form including all the limitations of the base claims and any intervening claims, and Applicant appreciates the same. However the Applicant is submitting points and authorities below as to the patentability of the base or independent claims and the patentability of all claims.

Information Disclosure Statement

The Applicant notes the Examining Attorney has stated that only the references cited on the form PTO-892 have been considered in this case.

In compliance with 37 C.F.R. §§ 1.56, 1.97 and 1.98, the Applicant provides herewith an Information Disclosure Statement on forms PTO/SB/08A-08B (3 pages). Citation of these references is respectfully requested.

Obviousness - Section 103(a) Rejection

The Examiner has rejected claims 1-4, 7-16 and 18-21, asserting that the claims are obvious under Section 103(a), over Jaeger. Applicant requests the Examiner reconsider the rejection for the reasons, points and authorities set forth below.

First of all, the Examiner asserts that the Jaeger reference includes all the elements of claim 1 for instance, except only for the electronic connector and specifying the type of signal processed by the system. The Applicant points out that the Jaeger reference does not include all the elements believed by the Examiner, as the Jaeger reference is directed to an entirely different and dated spray cooling technology, and not to "evaporative spray cooling" as this invention is. Therefore the reference or combination of the reference with what the Examiner claims is obvious to a person in the art, does not include all the elements or limitations of the claims and therefore does not meet the Examiner's duty to set forth a *prima facie* case of obviousness.

The Jaeger reference is directed to "jet impingement" boiling heat transfer, which is a different technology than evaporative spray cooling, which utilizes a thin film, and therefore Jaeger actually teaches away from this invention. "Jet impingement" boiling transfer may for instance result in excess flow of coolant which floods a hot spot to be cooled as the vapor created from boiling becomes trapped and creates a hot spot, possibly resulting in what is generally referred to as burnout.

Next there is nothing in the Jaeger reference which suggests the desirability of the combination with evaporative spray cooling or with an electronic connector, and therefore the Examiner has not met the minimum required showing for *prima facie* obviousness. There is simply no motivation to make the combination or establish a *prima facie* case.

In the U.S. Court of Appeals for the Federal Circuit case of *In Re: Lee*, 61 U.S.P.Q. 2d 1430, decided January 18, 2002, the Federal Circuit held:

... Thus, when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The Board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

The examining attorney has therefore failed to meet the requirement to set forth with specificity the general knowledge in the art to enable a finding that the person having ordinary skill in the art would make such combination.

As the PTO recognizes in MPEP 2142:

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process.... The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of non-

obviousness.... The initial evaluation of *prima facie* obviousness thus relieves both the Examiner and Applicant from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to suggest the claimed invention.

MPEP 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re: Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Federal Circuit has several times expressly addressed the issue of how to evaluate an alleged case of *prima facie* obviousness to determine whether it has been properly made. Thus, *In re: Geiger* stated in holding that the PTO "failed to establish a *prima facie* case of obviousness:

Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ADC Hospital Systems, Inc. V. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Prior Art Made of Record and Not Relied Upon


The Applicant notes the prior art made of record but not relied upon and asserts that for the reasons set forth above, the claims are allowable over the art made of record.

Conclusion

Applicant therefore submits Claims 1 - 21 are in a position to proceed to allowance.

Respectfully submitted,

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By: 
Mark W. Hendricksen
Reg. No. 32,356